REMARKS/ARGUMENTS

Reconsideration is respectfully requested.

Claims 1-29 remain pending in this application.

Corrected Drawing

Amendment has been made to Figure 1 to replace reference numeral "58" with reference numeral "54" as disclosed on page 11, line 3 of the present specification as originally filed. No new matter is added.

A substitute sheet containing Figure 1 has been submitted concurrently herewith by separate paper entitled "Letter Submitting Formal Drawings".

Rejections Under 35 U.S.C. §103

In the instant Office Action, claims 1-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Vidyanand* (U.S. Patent 6,330,071) in view of *Suzuki, et al.* (U.S. Patent 5,923,013). These rejections are respectfully traversed.

Claim 1 recites, in part, an **identifying apparatus communicating with the converting apparatus** and operative to identify the static page layout objects in the manner allowing **for an optimized form to be created**, and to allow for appropriate merging with the variable print data, and an optimizer apparatus communicating with the identifying apparatus and operative to convert the static page layout objects to an optimized form, **wherein optimization level to create the optimized form is based on intended usage of the static page layout objects by a user**. (Emphasis added.)

The present specification defines "optimized form" as optimizing storage capacity of the static page layout objects. See page 12, line 30, to page 13, line 2.

The Office Action asserts that Vidyanand's Fig. 8 and col. 4, lines 48-56, discloses an identifying apparatus communicating with the converting apparatus and operative to identify the static page layout objects in the manner allowing for an optimized form to be created as recited in claim 1. Applicants traverse this assertion in view of the following:

Vidyanand's Fig. 14 and col. 4, lines 49-57 disclose combining the two parts of a job into a single job sent to the printer. The Assemble Print Job task 1404 assembles a print job by placing the master data in front of the variable data in a single print job which is then sent to the printer. See Vidyanand's col. 6, lines 42-46. The detection mechanism 1406 then detects the placing of "the master data in front of the variable data" as "special" and the print job is then forwarded to the Disassemble Print Job Task 1407 which disassembles the print job and overlays the proper variable pages onto the appropriate master pages. There is no teaching or suggestion of an identifying apparatus communicating with a converting apparatus, and further, no optimized form is created using the static page layout objects, as recited in claim 1. Where does Vidyanand disclose **converting the static page layout objects to an optimized form**?

Merely detecting the placing of the master data in front of the variable data as being special and then proceeding to disassemble such is not the same as creating an optimized form from the static page layout objects. Page 12, line 30, to page 13, line 2, defines the "optimized form" as recited in the claimed invention. Furthermore, where does Vidyanand disclose merging the created optimized form with the variable print data as recited in claim 1?

The Office Action allegedly analogizes Vidyanand's "master data" as "static layout objects" of the claimed invention, as Vidyanand's master data is combined with the variable data to generate a print job. For example, Vidyanand's col. 6, lines 42-44, merely disclose placing the master data in front of the variable data. Vidyanand fails to even make a mention of using the master data to create an optimized form prior to combining the master data with the variable data.

On page 3, lines 4-6, of the instant Office Action, the Examiner asserts that Vidyanand indicates that "detection mechanism 1406 detect(s) that the print job is a special job and puts it in optimized form". Even assuming for argument's sake that such is true, after detecting that the print job is special, Vidyanand disassembles the print job and "overlays the proper variable pages onto the appropriate master pages". See Vidyanand, col. 6, lines 53-55. If disassembling the print job is considered by the Office Action as "converting to

an optimized form" as recited in claim 1, then logically it does not make sense to merge the disassembled print job (having master data and variable data) again with the variable data. Moreover, Vidyanand fails to teach or suggest such.

In view of the above, Vidyanand fails to teach or suggest an **identifying apparatus communicating with the converting apparatus** and operative to identify the static page layout objects in the manner allowing **for an optimized form to be created**, and to allow for appropriate merging with the variable print data, and an optimizer apparatus communicating with the identifying apparatus and operative to convert the static page layout objects to an optimized form as recited in claim 1.

The Office Action acknowledges that Vidyanand failed to teach or suggest "wherein optimization level to create the optimized form is based on intended usage of the static page layout objects by a user" as recited in claim 1. However, the Office Action asserts that Suzuki cures Vidyanand's deficiencies. Specifically, the Office Action asserts that Suzuki's Fig. 9 and col. 7, lines 45-66, discloses "the user is being able to optimize or modify the job description file for revision wherein the optimization and modifications are being produced by the user in by in [*sic*] replaceSet field 64". Applicant respectfully disagrees in view of the following:

Suzuki discloses a print control system managing a print job on a job basis and on a page basis. Suzuki's Fig. 9 is a job description file (JDF) revision instruction file. It has nothing to do with "static page layout objects" and "variable print data" as recited in claim 1. Further, Suzuki's JDF revision instruction file as shown in Fig. 9 is for a print job — it is irrelevant to static page layout objects.

As alleged by the Examiner, in order for Suzuki to disclose that "wherein optimization level to create the optimized form is based on intended usage of the static page layout objects by a user", Suzuki must first create the optimized form. When Suzuki creates no optimized form, how can the Examiner allege that the optimization level to create the form is based on intended usage of the static page layout objects by the user. Further, when Suzuki fails to even make a mention of "static page layout objects", how can Suzuki's JDF revision file be interpreted to create an optimized form based on the intended usage of the

static page layout objects by the user. The Examiner is using "impermissible hindsight" to reconstruct the claimed invention.

Moreover, even if Suzuki's JDF revision instruction file with ReplaceSet field 64 is used in combination with the teachings of Vidyanand, all the elements of claim 1 are not met. For example, Suzuki's JDF revision instruction file allows a user to <u>reprint data</u> while modifying the job description file, and the ReplaceSet filed 64 is used to replace pages. See Suzuki, col. 7, lines 63-64. It is irrelevant to the user's intended usage of the static page layout objects in the merging of the static page layout objects with variable print data to create merged print data as recited in claim 1.

Applicant respectfully notes that MPEP §2142, entitled "Legal Concept of Prima Facie Obviousness" states:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest <u>all</u> the claim limitations. (Emphasis added.)

It would not be obvious to combine Vidyanand with Suzuki because 1) there is no teaching or suggestion in the references that would lead one of ordinary skill in the art to combine the references in the manner suggested by the Examiner; and 2) even if the references could be combined, the resulting product still would not have all the elements of the combination recited in the claim 1, as demonstrated above.

There are no teachings in the references themselves which teach that there would be any advantage resulting from selecting Suzuki's JDF revision instruction file and combining that somehow into the teachings of Vidyanand. If at all, Suzuki's ReplaceSet field 64 may be used to replace pages in Vidyanand's print job, and no more. If one of ordinary skill in the art were given Vidyanand and Suzuki, but not Applicant's disclosure, a resulting combination would not be claim 1. It would require impermissible hindsight to combine the references to arrive at the claimed invention. Even if the references are combined, it would still not result in claim 1.

In view of the above, claim 1 is patentably distinct over the combination of Vidyanand and Suzuki. Accordingly, claim 1 is allowable.

As claims 2-9, 22-25, and 26-29 depend from claim 1, they too are allowable.

For example, claim 4 further recites "the optimizer apparatus removes static page layout objects that are not in an optimized form during the converting activity in order to recover memory". (Emphasis added.)

The Office Action asserts that Vidyanand's Fig. 3 and col. 4, lines 20-32, teaches the above-recited claim 4. Applicant respectfully disagrees.

Vidyanand's col. 4, lines 20-32 discloses "the disk space occupied by the master data 302 is typically reclaimed when the system administrator purges the disk 301." Vidyanand clearly states **when the system administrator purges** the disk 301, the disk space occupied by the master data 302 is reclaimed. With regard to claim 1, the Examiner alleges that Vidyanand breaks up and converts job 701 into static page layout objects and variable data. Where does Vidyanand disclose that the master data 302 that is not in an optimized form during the converting activity is removed in order to recover memory? Vidyanand merely discloses that when the system administrator purges the disk 301, only then the disk space occupied by the master data 302 is reclaimed.

In view of the above, claim 4 is allowable.

For example, claim 23 further recites "wherein caching of the one or more layers is performed by establishing a link between individual ones of the layers and the static page layout objects". The Office Action asserts that Suzuki's col. 8, lines 11-28, teaches such claim feature. Applicant respectfully disagrees.

Suzuki's col. 8, lines 11-28, is irrelevant to the above-recited claim 23. Applicant is not sure how this disclosure of Suzuki is being read on claim 23. Suzuki's such disclosure discloses the input data acceptance module 76 accepts input data and sends it to the input data content determination module 78 which determines whether the input data is a print job, a JDF, JDF print instruction file, etc. Suzuki has nothing to do with static page layout objects. How is determining the type of input data as noted above related to "caching of the one or more layers is performed by establishing a link between individual ones of the layers and the static page layout objects" as recited in claim 23? When Suzuki

fails to teach or suggest static page layout objects, establishing a link between individual ones of the layers and the static page layout objects does not even arise.

Therefore, claim 23 is allowable.

Claims 10 and 15 are allowable for similar reasons set forth above with regard to claim 1. As claims 11-14 depend from claim 10, they too are allowable. As claims 16-20 depend from claim 15, they too are allowable.

Claim 21 is also allowable at least for similar reasons set forth above with regard to claim 1. Claim 21 further recites, in part, "individual ones of the static page layout objects include a field indicative of the intended use by the user." Neither Vidyanand nor Suzuki teach or suggest this feature in addition to the other deficiencies noted above with regard to claim 1.

For example, Suzuki ReplaceSet field 64 of the JDF Revision instruction file as shown its Figure 9 is not included in a static page layout object as required by claim 21. When Suzuki does not disclose a static page layout object, the ReplaceSet field 64 cannot be a part of an absent static page layout object.

Claim 21 is therefore allowable.

CONCLUSION

For all the reasons advanced above, Applicants respectfully submit that the application is in condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview before issuance of any such subsequent action.

Respectfully submitted,

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FIG. II